

REMARKS

The present Amendment amends claims 1, 2 and 5-7, leaves claims 3 and 4 unchanged, cancels claims 8-12, and adds claims 13-24. Therefore, the present application has pending claims 1-7 and 13-24.

Priority

Although the Examiner acknowledges that a certified copy of the priority documents has been received, the Examiner contends that a translation of the foreign application should be submitted under 37 CFR 1.55 if Applicants want to obtain the benefit of foreign priority under 35 U.S.C. §119(a)-(d). However, the Examiner has provided no rationale for making this requirement. Furthermore, a translation is not necessary to overcome the date of any of the references relied upon by the Examiner. In view of the costs involved in providing a translation and the lack of any apparent reason to provide the translation, Applicants respectfully request the Examiner to reconsider and withdraw this requirement.

Specification

The Examiner objects to the abstract of the disclosure, citing a minor informality. Where appropriate, Applicants have amended the abstract. Therefore, this objection is overcome.

Claim Objections

The Examiner objected to claim 1, citing a minor informality. Where appropriate, Applicants have amended claim 1. Therefore, the objection to claim 1, as now more clearly recited, is overcome.

35 U.S.C. §112 Rejections

Claims 7-12 stand rejected under 35 U.S.C. §112, second paragraph as failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. As indicated above, claims 8-12 were canceled. Therefore, this rejection with respect to claims 8-12 is rendered moot. This rejection with respect to the remaining claim 7 is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claim 7, fully complies with the requirements of 35 U.S.C. §112, second paragraph. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

35 U.S.C. §102 Rejections

Claims 1, 2, 7, 8, 10, and 12 stand rejected under 356 U.S.C. §102(e) as being anticipated by the program suite of “Adfax” and “Adcapture” of FutureTense, Inc. and applied to *The Boston Globe* website (www.boston.com/globe) (“Boston.com”). Furthermore, the Examiner asserts that the program suite has been described by the published articles of Editor & Publisher, *The Seybold Report*, Vol. 23, No. 22 (“Seybold 26-22”), *The Seybold Report*, Vol. 23, No. 22 (“Seybold 23-22”), *Business Wire*, and Peter Dyson and Rosanne Rosello (“Dyson”). As indicated above, claims 8-12 were canceled. Therefore, this rejection with respect to claims 8-12 is rendered moot. This rejection with respect to the remaining claims 1, 2 and 7 is traversed for the following reasons.

I. Invention Must be Patented or Described in a Printed Publication

The Examiner has rejected claims 1, 2 and 7 as being anticipated by the program suite of “Adfax” and “Adcapture” of FutureTense, Inc., and applies Boston.com. However the Examiner is reminded of the provisions of 35 U.S.C. §102(b), which provide that an invention must be “patented or described in a printed publication” in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. The Examiner has not provided or cited a printed publication for the program suite of “Adfax” and “Adcapture” of FutureTense, Inc., but rather appears to rely upon various publications that allegedly describe portions of the relied upon program suite. Therefore, Applicants submit that the rejection of claims 1, 2 and 7 as being anticipated under 35 U.S.C. §102(b) by the program suite of “Adfax” and “Adcapture” of FutureTense, Inc. is defective, and should be withdrawn.

II. A Single Prior Art Reference Must Teach Every Element of the Claims

The Examiner has rejected claims 1, 2 and 7 as being anticipated by the program suite of “Adfax” and “Adcapture” of FutureTense, Inc., and applies Boston.com. In the rejection, the Examiner also appears to rely upon Editor & Publisher, Seybold 26-22, Seybold 23-22, Business Wire, and Dyson. As indicated in MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Exceptions to this rule of law are described in

MPEP 2131.01, which reiterates that normally, only one reference should be used in making a rejection under 35 U.S.C. §102. A rejection over multiple references has been held to be proper when the extra references are cited to: (a) prove the primary reference contains an “enabled disclosure”; (b) explain the meaning of a term used in the primary reference; or (c) show that a characteristic not disclosed in the reference is inherent. The Examiner’s reliance upon Boston.com, Editor & Publisher, Seybold 26-22, Seybold 23-22, Business Wire, and Dyson does not appear to fall into any of these three categories. Although Applicants believe the 35 U.S.C. §102(b) rejection is defective in view of the Examiner’s reliance upon the program suite of “Adfax” and “Adcapture”, Applicants will address the rejection as applied to a single printed publication. Furthermore, because the Examiner relies upon Boston.com in the rejection of each of claims 1, 2 and 7, Applicants will specifically address the Boston.com reference with respect to the 35 U.S.C. §102(b) rejection.

III. Boston.com Does Not Teach Every Element of Claims 1, 2 and 7

Applicants submit that the features of the present invention, as now more clearly recited, are not taught or suggested by Boston.com, whether taken individually, or in combination with any of the other references of record. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Amendments were made to the claims to more clearly describe features of the present invention. Specifically, amendments were made to the claims to more clearly describe that the present invention is directed to an advertisement contents

providing method as recited in claims 1 and 2, and an advertisement contents providing system as recited in claim 7.

The present invention, as recited in claims 1 and 2, and as similarly recited in claim 7, provides an advertisement contents providing method and system for displaying, on an information apparatus connected to a network, advertisement contents registration that has been requested from a facsimile apparatus. The method includes a step of receiving facsimile registration information from the facsimile apparatus of an advertiser. The facsimile registration information indicates a registrant ID, a category ID, and the advertisement contents. The method also includes storing image data of the advertisement contents into the advertiser-dedicated page data corresponding to the registrant ID and the category ID. The advertiser-dedicated page data is in an advertisement service/management processing apparatus. The method also includes the steps of reading, from an advertiser information database, a facsimile number of the advertiser corresponding to the registrant ID, and acknowledging receipt of the advertisement contents by accessing the facsimile apparatus using the facsimile number read from the advertiser information database. In addition, the method includes sending a request for the advertisement contents from a subscriber-side processing apparatus to the advertisement service/management processing apparatus, where the advertisement contents are stored in the advertiser-dedicated page data in the advertisement service/management processing apparatus. The method also includes reading the advertisement contents from the advertiser-dedicated page data in the

advertisement service/management processing apparatus, where the advertisement contents are requested by the subscriber-side processing apparatus, and sending the advertisement contents to the subscriber-side processing apparatus. Another step of the method includes receiving the advertisement contents sent from the advertisement service/management processing apparatus and outputting the advertisement contents to an output device of the subscriber-side processing apparatus. The present invention further provides a step of using the facsimile number of the advertiser to access the facsimile apparatus, where the step of acknowledging receipt includes sending back the facsimile registration information to the facsimile apparatus of the advertiser, when the facsimile registration information is received. The prior art does not disclose all these features.

The above described features of the present invention, as now more clearly recited in the claims, are not taught or suggested by any of the references of record, particularly Boston.com, whether taken individually or in combination the other references of record.

Boston.com discloses a method of providing classified advertisements to a news publication via facsimile. However, there is no teaching or suggestion in Boston.com of the advertisement contents providing method and system as recited in claims 1 and 2, and as similarly recited in claim 7.

The Boston.com reference, as described in the first paragraph on page 8, describes an embodiment of a method for providing classified advertisements to a news publication via facsimile. An advertiser is instructed to dial a facsimile number

to fax its advertisement to the classified advertising department of the publication. The desired format, including preferred fonts and instructions for creating and preparing the faxed document are provided. As described in the second paragraph on page 8, the Boston.com reference also describes another embodiment, which is an automated fax response system. The system allows users to instantly receive information on demand by use of a touch tone phone. For example, a user can call a telephone number, enter document number 1001, and then receive a faxed list of available documents. The user can call again, and refer to the list of available documents to order more documents. The user can call and order up to 5 documents per phone call. The documents are then delivered to the user's fax machine within a matter of minutes.

The present invention, as recited in claim 1 and as similarly recited in claim 7, includes a step of receiving facsimile registration information from the facsimile apparatus of an advertiser. The facsimile registration information includes a registrant ID, a category ID, and the advertisement contents. The method also includes storing image data of the advertisement contents into advertiser-dedicated page data corresponding to the registrant ID and the category ID described in the facsimile registration information. Boston.com does not disclose these features. To support the assertion that Boston.com discloses these features, the Examiner cites page 8, paragraph 1 and pages 12-17. However, as described on page 8, paragraph 1, Boston.com merely discloses a procedure for providing faxed advertisements to a newspaper for inclusion in the classified ad section.

Furthermore, pages 12-17 merely describe the print rates and online only rates for advertising in *The Boston Globe*. Category IDs are listed for the different categories of ads. Nonetheless, there is no disclosure in Boston.com of receiving facsimile registration information including a registrant ID and a category ID, and storing image data of the advertisement contents into advertiser-dedicated page data corresponding to the registrant ID and category ID, as claimed.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 7, includes reading, from an advertiser information database, a facsimile number of the advertiser corresponding to the registrant ID. Boston.com does not disclose this feature. Specifically, there is no teaching or suggestion in Boston.com of an advertiser information database that includes the registrant ID of an advertiser and the facsimile number corresponding to that advertiser, in the manner claimed.

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 7, includes acknowledging receipt of the advertisement contents by accessing the facsimile apparatus using the facsimile number read from the advertiser information database. Boston.com does not disclose this feature. For example, as described on page 8, paragraph 1, Boston.com merely discloses the format and procedure desired for submitting a classified advertisement via fax. Furthermore, as described on page 8, paragraph 2, Boston.com discloses a separate and distinct embodiment for providing information on demand from a user, via fax delivery. That feature of Boston.com has no relation to providing

advertisement contents. Each of these features disclosed in Boston.com are quite different from acknowledging receipt of advertisement contents by using a facsimile number retrieved from the advertiser information database. In fact, as described on page 9 (under "Other Problems" (item 4)), Boston.com discloses where a confirmation e-mail is sent to an advertiser including the final price quote and exact line count, which is quite different from the features of the present invention.

Still yet another feature of the present invention, as recited in claim 2 and as similarly recited in claim 7, includes where the step of acknowledging receipt includes sending back the facsimile registration information to the facsimile apparatus of the advertiser identified by the registrant ID. Boston.com does not disclose this feature. As previously discussed, Boston.com merely discloses where a confirmation e-mail is sent to an advertiser including the final prices quote and exact line count of the submitted advertisement contents. This is quite different from the features of the present invention.

The above-described features regarding acknowledging receipt of the advertisement contents, while using the facsimile number read from the advertiser information database to access the facsimile apparatus, represents a significant distinction between the present invention and the method of Boston.com. By retrieving from a database the facsimile number corresponding to the registrant ID of an advertiser who has requested service, the present invention provides a notification to the advertiser matching the registrant ID that advertisement services have been requested. In this way, even if a third party inappropriately requests

services on behalf of the known advertiser by using the advertiser's registrant ID, the advertiser will be made aware that the third party is inappropriately requesting services on its behalf. The features of Boston.com, i.e., providing a confirmation e-mail to the source of the request by using the contact information provided by that source, does not solve the problem as does the present invention. Accordingly, Boston.com does not teach the claimed features.

Therefore, Boston.com fails to teach or suggest "receiving facsimile registration information from said facsimile apparatus of an advertiser, said facsimile registration information indicating a registrant ID, a category ID, and said advertisement contents, and storing image data of said advertisement contents into advertiser-dedicated page data corresponding to said registrant ID and said category ID described in said facsimile registration information, wherein the advertiser-dedicated page data is in an advertisement service/management processing apparatus" as recited in claim 1, and as similarly recited in claim 7.

Furthermore, Boston.com fails to teach or suggest "reading, from an advertiser information database, a facsimile number of the advertiser corresponding to the registrant ID" as recited in claim 1, and as similarly recited in claim 7.

Even further, Boston.com fails to teach or suggest "acknowledging receipt of the advertisement contents by accessing the facsimile apparatus using the facsimile number read from the advertiser information database" as recited in claim 1, and as similarly recited in claim 7.

Yet even further, Boston.com fails to teach or suggest "wherein the step of acknowledging receipt includes sending back said facsimile registration information to said facsimile apparatus of said advertiser identified by said registrant ID in said facsimile registration information, when said facsimile registration information is received" as recited in claim 2, and as similarly recited in claim 7.

Therefore, Boston.com fails to teach or suggest the features of the present invention, as now more clearly recited in the claims. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 2 and 7 are respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 1, 2 and 7.

35 U.S.C. §103 Rejections

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Boston.com in view of International Publication No. WO/396657 to Greenberg.

Claims 5, 6, 9, and 11 stand as being unpatentable over Boston.com in view of Editor & Publisher. As indicated above, claims 9 and 11 were canceled. Therefore, this rejection with respect to claims 9 and 11 is rendered moot. These rejections with regard to the remaining claims 3-6 is traversed for the following reasons.

Applicants submit that claims 3-6 are dependent on claim 1. As such, these claims should be allowed for at least the reasons previously discussed regarding

independent claim 1. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

New Claims 13-24

New claims 13-24 were added so as to more clearly describe the features of the present invention. Specifically, the claims were added to more clearly describe that the present invention is directed to a method and apparatus for providing advertisement contents as recited, for example, in independent claims 13 and 19.

The features of the present invention, as recited in independent claim 13 and as similarly recited in independent claim 19, are not taught or suggested by any of the references of record. More specifically, the features are not taught or suggested by Boston.com, whether taken individually or in combination with any of the other references of record.

For example, Boston.com fails to teach or suggest "reading, from an advertiser information database, a facsimile number of the advertiser corresponding to the registrant ID" as recited in claim 13, and as similarly recited in claim 19.

By way of further example, Boston.com fails to teach or suggest "using the facsimile number read from the advertiser information database to access the facsimile apparatus" as recited in claim 13, and as similarly recited in claim 19.

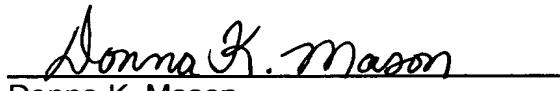
In view of the foregoing amendments and remarks, Applicants submit that claims 1-7 and 13-24 are in condition for allowance. Accordingly, early allowance of claims 1-7 and 13-24 is respectfully requested.

U.S. Application No. 09/924,524

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. 500.40472X00).

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.



Donna K. Mason
Registration No. 45,962

DKM/sdb
(703) 684-1120

Attachment:
Substitute Abstract